REMARKS

Applicants concurrently file herewith a Petition for Extension of Time, and corresponding extension of time fee, for a three-month extension of time.

Claims 1-15 are all of the claims presently pending in the application. Claim 14 has been amended to more particularly describe the claimed invention.

It is noted that the claims amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims, or for any statutory requirements of patentability. Further Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-10 and 12-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okaniwa et al. (U.S. Patent No. 6,444,621; hereinafter "Okaniwa"), in view of Oka et al. (U.S. Patent No. 6,782,771; hereinafter "Oka") and further in view of Alexander (U.S. Patent No. 4,822,505). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Okaniwa in view of Oka and Alexander, and further in view of Hasegawa et al. (U.S. Patent No. 5,550,190; hereinafter "Hasegawa").

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1, on the other hand, provides an electric power steering device including a lubricant including a grease, a base oil of the grease having a kinetic viscosity of 1000 to 5000 mm^2/s at 40°C and which is charged between the male type joint member and the female type joint member (e.g., see Application at page 3, line 20

through page 4, line 5). This combination of features is important for providing an electric power steering device where the O-ring is omitted, so that the productivity can be enhanced, while maintaining an excellent high temperature working property and preventing gear noise (see Application at page 3, lines 11-18).

The claimed invention of exemplary claim 14, on the other hand, provides an electric power steering device including a grease having a worked penetration of which is not more than 200 (e.g., see Application at page 14, lines 14-17). This combination of features is important for providing an electric power steering device where the O-ring is omitted, so that the productivity can be enhanced, while maintaining an excellent high temperature working property and preventing gear noise (see Application at page 3, lines 11-18).

II. THE PRIOR ART REJECTIONS

A. Claims 1-10 and 12-15

The Examiner alleges that Okaniwa would have been combined with Oka and Alexander to teach the claimed invention of claims 1-10 and 12-15. Applicants submit, however, that these references, even if combined, would not teach or suggest each and every feature of the claimed invention.

That is, Applicants submit that Oka would not have been combined with Okaniwa as alleged by the Examiner. Indeed, the Examiner's motivation to modify Okaniwa ("to provide details of a well-known power steering system, and therefore define the scope of the invention") does not appear to be a problem in Okaniwa that would require a solution.

Indeed, the scope of the invention of Okaniwa is clearly defined in Okaniwa, and does not require further definition from the teachings of Oka. That is, Okaniwa is clearly directed

to providing a grease composition, which has load resistance and wear-reducing ability high enough to use the grease under severe lubricating conditions (e.g., see Okaniwa at column 1, lines 58-64). The objectives of Okaniwa are met by the specific grease composition defined therein (e.g., see Okaniwa at column 2, lines 12-18). Thus, the "scope of the invention" of Okaniwa is clearly defined in Okaniwa itself.

Furthermore, as pointed out in the Amendment filed on November 17, 2005, Okaniwa is not directed to a power steering system. Thus, the scope of the invention of Okaniwa is not related to a power steering system. Therefore, the teachings in Oka would not further define the scope of the invention of Okaniwa, because Oka is not related to a grease composition, which has load resistance and wear-reducing ability high enough to use the grease under severe lubricating conditions.

Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". That is, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP itself).

Furthermore, Applicants submit that Alexander would not have been combined with Okaniwa and Oka as alleged by the Examiner. Indeed, the Examiner's motivation to modify Okaniwa and Oka ("to provide a particular grease for a specific application, thus increasing applicability") does not appear to be a problem in Okaniwa and Oka that would require a solution.

Indeed, the Examiner alleges that "[i]t is clear that the viscosity is determined via selection of a particular base oil, the selection being application specific" (see Office Action dated January 26, 2006 at page 3). Assuming, *arguendo*, the Examiner is correct, Applicants

point out that the specific application for which the particular grease was chosen in Alexander is different from the specific application in Okaniwa.

That is, in Alexander additives were selected to provide an enhanced load-carrying capability (see Alexander at column 1, lines 33-41). In contrast, the grease composition in Okaniwa was selected for enhancing load resistance, wear-reducing ability and operability at low temperatures (e.g., see Okaniwa at column 1, lines 58-64). Therefore, the grease in Alexander was selected for a different specific application than the grease in Okaniwa. Therefore, one of ordinary skill in the art would not have been motivated or suggested to combine the teachings of Alexander with the grease composition of Okaniwa, as alleged by the Examiner.

Furthermore, even if the Examiner argues, *arguendo*, that the specific applications in Okaniwa and Alexander are the same, one of ordinary skill in the art would not have been motivated to combine the base lubricant of Alexander with the grease composition of Okaniwa, as alleged by the Examiner.

That is, Alexander teaches a lubricating oil having a viscosity in a range of 5 to about 10,000 cSt at 40°C, which the Examiner alleges would have been combined with Okaniwa. However, the lubricating oil in Alexander does not provide enhanced load-carrying capability. Indeed, this feature of Alexander is provided by the additives in the composition. Thus, the specific additives, not the lubricating oil, in Alexander are selected in accordance with the specific application in Alexander.

Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". That is, "the mere fact that references <u>can</u> be combined or modified does not render the

resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP itself).

Moreover, neither Okaniwa nor Oka nor Alexander, nor any combination thereof, teaches or suggests an electric power steering device including "*a lubricant including a grease, a base oil of said grease having a kinetic viscosity of 1000 to 5000 mm^2/s at 40°C*", as recited in claim 1, and similarly recited in claim 12.

The Examiner concedes that "Okaniwa nor Oka discloses the grease as including a base oil having a kinetic viscosity of 1000-5000 mm-sp/s at 40°C" (see Office Action dated January 26, 2006 at page 3).

The Examiner alleges that Alexander teaches this feature. The Examiner attempts to rely on column 1, lines 56-63 of Alexander to support his allegations. The Examiner, however, is clearly incorrect.

Indeed, nowhere in this passage (nor anywhere else for that matter) does Alexander teach or suggest an electric power steering device including a lubricant including a grease, a base oil of the grease having a kinetic viscosity of 1000 to 5000 mm^2/s at 40°C. Indeed, Alexander teaches a broader viscosity range of 5 to 10,000 cSt at 40°C.

Applicants point out that M.P.E.P. §2144.05B.III. states that Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the importance of the claimed range. That is, "[t]he law is replete with cases in which the differences between the claimed invention and the prior art is some range or other variable within the claims" (see M.P.E.P. §2144.05B.III.). Thus, in order to rebut a *prima facie* case of obviousness the applicant must show that the particular range is important.

Applicants submit that the claimed range for kinetic viscosity is clearly important.

Indeed, the specification discloses that when the kinetic viscosity of the base oil is lower than the claimed range, the viscosity becomes too low. Thus, it is impossible to prevent the generation of gear noise in the spline joint. Furthermore, when the kinetic viscosity is higher than this range, the viscosity is too high, which deteriorates the working property of assembling (e.g., see Application at page 13, lines 15-27). Therefore, the claimed range is clearly important.

Moreover, neither Okaniwa nor Oka nor Alexander, nor any combination thereof, teaches or suggests "*a worked penetration of which is not more than 200*", as recited in claim 14.

The Examiner alleges that Okaniwa teaches this feature. The Examiner attempts to rely on item 11 of Table 1 of Okaniwa to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this passage (nor anywhere else for that matter) does Okaniwa teach or suggest an electric power steering device including a grease having a worked penetration of which is not more than 200. Indeed, each penetration value listed in Table 1 of Okinawa is greater than 200. Therefore, Okaniwa clearly fails to teach or suggest this claimed range.

Furthermore, Applicants submit that Oka and Alexander fail to make up the deficiencies of Okaniwa regarding claim 14. Indeed, the Examiner does not even allege that Oka or Alexander teaches or suggests a grease having a worked penetration of which is not more than 200.

Thus, regarding claim 14, Oka and Alexander fail to make-up the deficiencies of Okaniwa.

Therefore, Applicants submit that these references would not have been combined and that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

B. Claim 11

The Examiner alleges that Hasegawa would have been combined with Okaniwa, Oka and Alexander to teach the claimed invention of claim 11. Applicants submit, however, that even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, neither Okaniwa nor Oka nor Alexander nor Hasegawa, nor any combination thereof, teaches or suggests an electric power steering device including "*a lubricant including a grease, a base oil of said grease having a kinetic viscosity of 1000 to 5000 mm^2/s at 40°C*", as recited in claim 1.

As detailed in section A, above, neither Okaniwa nor Oka nor Alexander, nor any combination thereof, teaches or suggests this feature. Furthermore, Applicants submit that Hasegawa does not make up the deficiencies of Okaniwa, Oka and Alexander.

Indeed, nowhere does Hasegawa teach or suggest an electric power steering device including a lubricant including a grease, a base oil of the grease having a kinetic viscosity of 1000 to 5000 mm^2/s at 40°C. The Examiner does not even allege that Hasegawa teaches or suggests this feature. Indeed, the Examiner merely alleges that Hasegawa teaches a synthetic resin composite including poylbutylene terephtalate (see Office Action dated January 26, 2006 at page 3).

Thus, Hasegawa fails to make up the deficiencies of Okaniwa, Oka and Alexander.

Therefore, Applicants submit that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

Applicants **again** respectfully request the Examiner to acknowledge Applicants' claim to foreign priority, which was made on March 10, 2004.

In view of the foregoing, Applicants submit that claims 1-15, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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